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9-28-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Van Ee et al.

Attorney Docket
PH23,409

Serial No.: 09/217,414

Group Art Unit: 2151

Filed: December 21, 1998

Examiner: Ho, T.

Title: CLUSTERING OF TASK-ASSOCIATED OBJECTS FOR EFFECTING
TASKS AMONG A SYSTEM AND ITS ENVIRONMENTAL DEVICES

Honorable Commissioner of Patents and Trademarks
Washington, DC 20231

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REQUEST FOR RECONSIDERATION

OFFICIAL

Sir:

In response to the Examiner's Office Action mailed on May 21, 2003, Applicant respectfully requests reconsideration.

Claims 1-6, 10-15, 17-27 and 30 are rejected under 35 USC Section 103(a) as being unpatentable over Humpleman et al. '716. Claims 7-9, 16, and 28-29 are rejected under 35 USC Section 103(a) as being unpatentable over Humpleman et al. '716 in view of Darbee.

Section 2142 of the MPEP states the following:

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the Examiner's Office Action of May 21, 2003, on page 3, lines 11-14, the Examiner states that Humpleman et al. '716 teaches "[A] cluster formulation subsystem (software and/or

hardware saving the particular steps taken by a user while interacting, line 18-19 column 22) formulates clusters (macro, line 30 column 21), being responsive (macro generation 1204, Fig. 15) to context (session manager...saved states into actions, lines 8-11 column 15)..." Further, in the Examiner's Office Action of May 21, 2003, on page 4, lines 8-12, the Examiner states "Humpleman et al. '716 does not explicitly disclose objects of a cluster. However, Humpleman et al. '716 disclose in 804 of Fig. 1 several objects that the user can interact with (channel, brightness...). It would have been obvious to consider this teaching as objects of a cluster wherein after the user clicks on one of the object, a task that is specified to that object would be performed."

One, Applicants respectfully submit that the rejection is improper because there is no item 804 in Figure 1. If the Examiner is referring to item 104, this is network interface unit. If the Examiner is referring to item 804 as shown in Figure 11, this is the home page of a display unit (col. 18, lines 10-11). Applicants request that the Examiner indicate whether it should be Figure 1 or Figure 11 as used in the rejection.

Two, Applicants respectfully submit that the rejection is improper because the motivation to modify Humpleman et al. '716 is not clear from the reference nor from the Examiner's statements. Under MPEP 2142, "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986)." Applicants respectfully submit that stating that "[i]t would have been obvious to consider this teaching" does not provide a proper motivation statement to make a modification of Humpleman et al. '716. Therefore, the requirement that the Examiner make a *prima facie* case has not been met.

Three, Applicants respectfully submit that the rejection is improper because the prior art must teach or suggest all of the claim limitations. Claim 1 recites "the cluster presentation subsystem supports the formatting and presentation of task-associated objects of an active cluster responsive to context". Applicants respectfully submit that the Examiner has not addressed this limitation of Claim 1 in the Office Action of May 21, 2003.

Four, claim 1 states "the state tracking subsystem supports context determination; the cluster formulation subsystem formulates clusters, each cluster comprising selected objects, such formulation being responsive to context ..." Applicants are consistently using the term "context" to have the same meaning. However, Applicants respectfully submit that when addressing the state tracking subsystem clause of Claim 1, the Examiner views Humpleman et al. '716 as teaching that "context" as used in "the state tracking subsystem supports context determination" is the particular state of the device (see Col. 10, lines 29-31 of Humpleman et al. '716 which gives examples of different states). When discussing the cluster formulation subsystem clause of Claim 1, the Examiner states "being responsive (macro generation 1204, Fig. 15) to context (session manager ...saved states into actions, lines 8-11 column 15)" (see Office Action of May 21, 2003, page 3, lines 13-14). Applicants submit that the Examiner is not being consistent in the use of the term "context" when attempting to anticipate the Applicants' claims.

Five, the Applicants submit that the Examiner is using impermissible hindsight in modifying Humpleman et al. '716. There is no teaching or motivation in Humpleman et al. '716 to modify the clusters to include objects. As stated in MPEP 2143.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness."

With regards to claims 2-30, please note the discussion of claim 1 above.

Extension of Time Statement

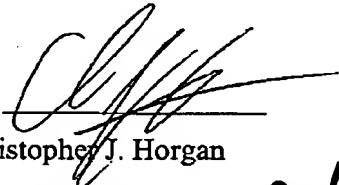
The Commissioner is hereby requested and authorized pursuant to 37 CFR §1.136(a)(3), to treat any concurrent or future reply in this application requiring a petition for extension of time for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. Please charge any additional fees which may now or in the future be required in this application, including extension of time fees, but excluding the issue fee unless explicitly requested to do so, and credit any overpayment, to Deposit Account No. 14-1270.

Conclusion

It is respectfully urged that claims 1-30 are allowable. Wherefore, it is respectfully requested the decision of the Examiner finally rejecting Claims 1-30 be reversed in all respects.

Respectfully submitted,

Date: September 22, 2003

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Enclosed:
Response


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